

REMARKS

Applicants gratefully acknowledge that the Examiner has allowed claims 53 and 76-81.

DRAWINGS

The Draftsperson has objected to the drawings filed August 17, 1999 under 37 C.F.R §§ 1.84 and 1.152. In response, Applicants refer the Draftsperson's attention to the formal drawings that were filed on April 25, 2003.

THE REJECTIONS BASED UPON NON-STATUTORY DOUBLE PATENTING

Claim 70 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,414,134. In order to expedite allowance of the present application, and without prejudice or disclaimer to Applicant's rights to pursue such claims in one or more continuing applications with or without filing a Terminal Disclaimer, Applicants have elected to provide a Terminal Disclaimer in this application disclaiming any term that would extend beyond the terms of U.S. Patent No. 6,414,134.

According to the M.P.E.P., there is no statutory prohibition against withdrawing a recorded terminal disclaimer which was erroneously filed before the patent issues:

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than refiling it as a CPA). §1490(A).

Accordingly, Applicants reserve the right to withdraw the aforementioned terminal disclaimer.

**THE REJECTIONS UNDER 35 U.S.C. § 112, SECOND
PARAGRAPH, SHOULD BE WITHDRAWN**

The Examiner has rejected pending claims 71, 73, 75 and 82-88 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Applicant regards as their invention.

Specifically, the Examiner contends that the claims are indefinite since the claimed target is a protein amino acid sequence and the anticodon oligomers are not defined in the specification as able to bind a protein. In particular, the Examiner, referring to the substitute sequence list filed on May 7, 2001, points out that SEQ ID NO.:22 is an amino acid sequence and not a nucleic acid sequence.

In response, Applicants submit herewith, a substitute sequence list that properly describes SEQ ID NO.:20 and 22 as nucleic acid sequences. Applicants also point out that the nucleic acid sequences of instant SEQ ID NO.:20 and 22, that are submitted concurrently in the substitute sequence list, do not add new matter. In support of this fact, Applicants respectfully point the Examiner's attention to the original specification as filed, particularly to pages 69 and 72, that describes nucleotide sequences that are identical to the nucleotide sequences of SEQ ID NO.:20 and 22.

For the forgoing reasons, Applicants assert that the Examiner's rejection of claims 71, 73, 75 and 82-88 under 35 U.S.C. § 112, second paragraph, has been obviated and the claims are therefore in proper condition for allowance.

**THE REJECTIONS UNDER 35 U.S.C. § 112, FIRST
PARAGRAPH, SHOULD BE WITHDRAWN**

The Examiner has rejected pending claim 72 under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter which was not described in the specification in such a way as to convey to one skilled in the relevant art possession of the invention. In particular, the Examiner contends that claim 72 lacks written description for a representative number of species of the claimed antisense to a splice acceptor region of SEQ ID NO:19.

Applicants assert that the specification has not only identified an example of an antisense oligonucleotide that is complementary to a splice acceptor region (see, *e.g.*, the specification at page 13, lines 8-12), but also describes structural features of the splice

acceptor region of the bcl-2 gene to allow one skilled in the art to identify antisense oligonucleotides that are complimentary to this region (see, *e.g.*, the specification at page 4, lines 31-33). In particular, the specification describes oligonucleotides that target an effective portion of the splice acceptor region as preferably complimentary to an AG consensus sequence within the splice acceptor region of the bcl-2 gene (see, *e.g.*, the specification at page 4, lines 27-35). For example, the specification describes an anticodon oligomer that targets a splice acceptor region as one that comprises at least a TC portion which is complimentary to the AG portion of the splice acceptor of the bcl-2 gene (see, *e.g.*, the specification at page 4, lines 30-33). Thus, using the general knowledge in the art relating to consensus sequences found in eukaryotic genes and the known sequence of the bcl-2 gene, one skilled in the art, provided with the instant specification, would easily be able to identify antisense oligonucleotides targeting splice acceptor regions. Clearly, one skilled in the art would be able to understand with ease the necessary structural features and limitations of the claimed invention when reading the specification in light of that well-known in the art at the time of filing.

Applicants respectfully assert that the invention as presently claimed is fully described by the instant specification and as such, the rejection under 35 U.S.C. § 112, first paragraph, should be withdrawn. Applicants respectfully remind the Examiner that when a skilled artisan understands the inventor to be in possession of the claimed invention, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. As such, claim 72 is fully supported by the instant specification.

THE REJECTION UNDER 35 U.S.C. § 102(e) AND (b) SHOULD BE WITHDRAWN

The Examiner has rejected pending claim 70 under 35 U.S.C. § 102(e) as being anticipated by Capaccioli *et al.* (U.S. Patent No. 6,005,095) and under 35 U.S.C. § 102(b) as being anticipated by Capaccioli *et al.* (WO 96/27663) (the “Capaccioli references”). Applicants assert that the present invention is not anticipated by the Capaccioli references as neither of the cited references qualify as prior art against the instant application.

The instant application claims the benefit of priority under 35 U.S.C. § 120 to U.S. application Serial No. 07/288,692, filed December 22, 1988. In support, Applicants respectfully point the Examiner’s attention to the “request for priority” that was filed by the

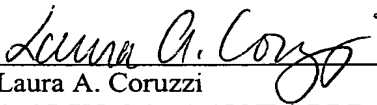
Applicants and marked received by the Office on August 17, 1999. Applicants note that the Capaccioli reference relied upon by the Examiner for the 102(b) rejection, *i.e.* WO 96/27763, claims priority to an application filed on March 3, 1995. Moreover, the Capaccioli reference relied upon by the Examiner for the 102(e) rejection, *i.e.* U.S. Patent No. 6,005,095, bears a 102(e) and § 371 date of December 15, 1997. As such, the priority date for which the claimed invention is entitled predates the cited art and therefore, the Examiner's rejection of claim 70 as being anticipated by either of the Capaccioli references is improper and must be withdrawn.

CONCLUSION

Applicants respectfully request entry of the foregoing remarks into the file of the above-identified application. Applicants believe that each ground for rejection or objection has been overcome or obviated, and that all of the pending claims are in condition for allowance. Withdrawal of all outstanding rejections and objections is therefore respectfully requested. An early allowance is earnestly sought.

Date: October 15, 2003

Respectfully submitted,



Laura A. Coruzzi 30,742
(Reg. No.)
PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, New York 10036-2711
(212) 790-9090